

### **REMARKS**

Claims 1-11 and 13-19 are pending in the application. Claims 1-11 and 13-19 stand rejected as being allegedly unpatentable pursuant to 35 U.S.C. § 103. Figure 8, which was submitted with the July 15, 2003, Response, has been objected to and not entered as allegedly being in violation of 37 C.F.R. § 1.83(a).

### **THE SPECIFICATION**

The specification has been amended herein to remove reference to Figure 8. Nevertheless, the undersigned submits that support for Figure 8, and its accompanying modifications to the specification, which are being deleted in this Request for Reconsideration, can be at least found at page 5, lines 22-25 of the originally filed specification.

### **THE CLAIMS**

Claims 1, 5-6, and 8 stand rejected as being allegedly unpatentable over Yavitz (5,600,902) in view of Evans (6,032,386). In making this rejection, the Office action argues that "it would have been obvious to use a sneaker with a planar sole as is well known and taught by Evans and to provide a plurality of cleats as the traction means on the removable outsole as taught by Evans in the footwear system of Yavitz to provide a different known style of sneaker and to provide increased traction, different levels of traction, or different types of traction." In other words, the Office action is seeking to modify Yavitz to include a plurality of spikes or other sports cleats on the underside of its article or pad 10. As explained in greater detail below, the undersigned submits that such a modification is impermissible because Yavitz teaches away from such a combination and because such a combination would render Yavitz, the primary reference, useless for its intended purpose. As also explained below, the undersigned submits that there would be no motivation to add a plurality of sport cleats to the pad 10 in Yavitz as the golf shoe in Yavitz already has spikes on it and because the pad 10 is intended to be used on a putting green so there is no reason to add sport cleats to it. For at least these reasons, claims 1, 5-6, and 8 are patentable over the cited references.

Yavitz is entitled "Removable Pads For Use With Spiked Golf Shoes To Protect Putting Greens" (emphasis added) and regards an article "designed for attachment to

golf shoes to protect the surface integrity of putting greens on a golf course.” See Yavitz Abstract. The pad or article in Yavitz can be “removably attached to the bottom of a golf shoe to prevent conventional spikes from penetrating the surface of the green.” See Yavitz Abstract. In sum, Yavitz regards a system for protecting putting greens from golf shoe spikes. See, *also*, Yavitz Abstract; col. 1, lines 9-10; see *also*, col. 2, lines 5-6; col. 3, lines 42-46; and col. 4, lines 5-7. Consequently, Yavitz teaches away from placing spikes on the bottom of the pad 10 as such spikes would be deleterious to putting greens, something Yavitz is seeking to cure. Furthermore, if sport cleats were placed on the bottom of the pad 10 of Yavitz, the pad 10 would no longer be useful for its intended purpose (to protect putting greens) and the pad would no longer function as intended (“to prevent penetration of the green’s surface by the golf shoe spikes during putting,” see Abstract). This is further proof that the modification suggested by the Office action is improper.

As to the Office action’s assertion that it would have been “obvious to ... provide a plurality of cleats as the traction means on the removable outersole as taught by Evans in the footwear system ... to provide increased traction, different levels of traction, or different types of traction,” the undersigned submits that there would be no motivation to add sport cleats, as claimed, to the bottom of the pad in Yavitz because the golf shoe in Yavitz already has golf spikes on it. Such an addition, as suggested by the Office action, would be redundant. Consequently, there would be no motivation to make such a modification.

The arguments made in the Office action to support its “mere reversal of elements” contention are misplaced. First, the proposed modification to Yavitz renders it unsatisfactory for its intended purpose of protecting grass putting greens during putting. A modification to a reference that makes it unsatisfactory for its intended purpose violates *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1994). Second, with regard to the Office Actions’s suggestion that the golf shoe in Yavitz would be spikeless and would only contain spikes when the pad 10 was placed on the spikeless shoe, the undersigned submits that this proposed modification changes the principle of operation of Yavitz and is therefore in violation of *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Moreover, such a modification is also improper because without spikes there would be no way to attach the pad 10 to a shoe. And if the spikes were to remain to provide a securement means, there would be no reason to add a redundant set as suggested. Still further, absent the teachings of the applicant’s

disclosure, if a golfer wanted to add spikes to his or her shoe, there is no reason to believe they would proceed as suggested in the Office action. Moreover, there would be no motivation to add the claimed sport cleats to Yavitz because the pad 10 in Yavitz is only used on grass putting greens and such sport cleats would damage the grass putting greens.

As to the alleged motivations identified in the Office action, the undersigned submits that the motivation “to provide a different known style of sneaker” provides no genuine motivation at all as such a general statement could be said about an infinite number of things. Furthermore, as none of the numerous cited references contain the claimed invention, this too shows that the claimed invention was not “known” as alleged in the Office action. With regard to increasing traction, providing different levels of traction, and different types of traction, such motivations would not apply as the pad in Yavitz is used on a putting green, where traction is not a concern to a golfer and damaging the green is a substantial concern. See e.g., Yavitz at col. 1 lns. 6-11, 31-32 (identifying that penetrating the greens with a golf spike is undesirable and describing how traction is important during the approach to the green).

For each of these reasons, claims 1 and 8, and their dependent claims, are all patentable over Yavitz and Evans.

Claims 2 and 9 stand rejected under 35 U.S.C. § 103(a). The undersigned submits that it would be improper to modify Yavitz with a cap or strap band as suggested by the Office action, because this would further complicate the manner in which the pad is attached to the foot wear in Yavitz. Yavitz teaches that the pad 10 is coupled to a golfer's shoe by “simply plac[ing] a pair of pads 10 on the ground, [and] step[ping] onto the pads 10 to permit penetration of the spikes.” Thus, Yavitz teaches a simple process for attaching the pad 10 to a golf shoe. (Each of the other embodiments of Yavitz are also designed to permit the golfer to simply place the pads on the ground and step into them.) If the pad 10 were modified, as suggested by the Office action, the golfer would no longer be able to simply step into the pad to attach it to his or her shoe. Instead, a golfer would be forced to take additional steps to couple the pad to the golf shoe. Such a change is not obvious. Rather, it is counterintuitive as it would further complicate the coupling process of Yavitz. Furthermore, such a proposed modification would change the principle of operation of the pad, which is intended to be stepped into, rather than secured with the intervention of a user's hands.

Thus, the undersigned submits that such a combination is impermissible and violative of *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

With regard to claim 6, none of the references cited in the Office action contain a soccer cleat, a rugby cleat, a baseball spike, a football spike, or a track sprinter's spike, for at least this reason, claim 6 is patentable over the cited references.

With regard to claim 7, the undersigned submits that the cited references fail to disclose or suggest a removable outersole system "wherein the sport cleats are in the shape of a truncated cone with conical sides and have at least two different heights relative to one another," as recited in the claim. As to Johnson, one of the references cited in the Office action, the undersigned submits that this reference is not analogous art and can not be relied upon as it does not regard a removable outersole. However, even if Johnson is considered, which it should not be, the spikes in Johnson are not truncated cones with conical sides and, therefore, do not provide a basis for rejecting claim 7. This is made clear by fig. 2, which shows the flat surfaces of the outer edge of the fan like spikes. Likewise, the inner spikes are also not truncated cones but are, rather, complete cones with visible tips. Still further, the sides of these inner cones are not conical, but are, rather, straight.

The Office action also fails to provide a sound motivation for combining the references in its rejection of claim 7. The Office action alleges that "it would have been obvious to use a cleat pattern as taught by Johnson in the system and inherent method of using a system of Yavitz as modified above to provide traction means/cleat pattern which is appropriate for both natural surfaces and artificial surfaces." In short the Office action is arguing that modifying the spikes make it more suitable for artificial and natural surfaces. However, Yavitz regards golf shoes and making them more hospitable to grass putting greens. Consequently, there would be no motivation to make golf shoes more suitable for artificial turf where golf is not played; as such, there is no motivation to combine the references. For at least each of these reasons, claim 7 is patentable over the cited references.

Claim 13 stands rejected under 35 U.S.C. § 103. Claim 13 is directed to a method of securing turf knobs to a spikeless athletic foot covering with bottom treads and a top. Drawing from the above discussion of claims 1 and 8, the undersigned

submits first that Yavitz has spikes and is not spikeless. Moreover, it would also be improper to add turf knobs to the bottom of the pad 10 of Yavitz as this would go against the purpose and operation of Yavitz. Still further, as also discussed above, there would be no motivation to make such a combination. Accordingly, for each of these reasons, claims 13-19 are patentable over the cited references.

As to claim 14, the undersigned submits that it is improper to suggest that Yavitz can be modified by any of the cited references to include the step of lacing a support band over the top of the athletic foot covering as recited in claim 14. As discussed above, Yavitz praises its ease of connection when it says a user can “simply” step onto the pad 10. Adding a lacing step or any other attachment step would impermissibly complicate the simple coupling process taught by Yavitz. For at least this reason, claim 14 is patentable over the cited reference.

#### THE OFFICE ACTION IS SILENT ON CERTAIN CLAIM LANGUAGE

With regard to claim 2, there is no discussion in the Office action regarding the “the sole plate formed in the same shape as the sole surface,” as recited in the claim.

With regard to claim 3, the Office action does not discuss or address a “sole plate ... formed in the same size as the sole surface,” as recited in the claim.

With regard to claim 4, as with claims 2 and 3 above, there is no discussion of “the sole surface containing a sole plate, the sole plate having an exposed top surface, the sole plate being rigid, continuous, unbroken, and sized to the same dimensions as the substantially flat treaded bottom of the athletic foot covering.”

As to claim 8, the Office action does not address the language that “the sole plate being the same size and dimension as the permanent treaded external sole of the sneaker, the sole plate being uncovered,” as recited in the claim.

As to claim 17, the Office action fails to address “the rigid sole plate being in the same dimension and size as the perimeter of the bottom treads of the athletic foot covering,” as recited in the claims.

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This lack of discussion can be a basis for withdrawing the finality of the Office action.


### **CONCLUSION**

The undersigned requests reconsideration and allowance of each of the rejected claims.

The Examiner is invited to contact the undersigned at 202-220-4311 with any questions or comments.

Respectfully submitted,

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